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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/292,056	04/14/1999	JOEL S. GREENBERGER	PITT-1DIV	3040

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EXAMINER

SOUAYA, JEHANNE E

ART UNIT PAPER NUMBER

1634

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/292,056**Applicant(s)  
**Greenberger et al**Examiner  
**Jehanne Souaya**Art Unit  
**1634**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jan 21, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Jan 21, 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see Attachment

3. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_  
\_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none
- Claim(s) objected to: none
- Claim(s) rejected: 1, 47-64, 70, 74-81, 86-97, 99, 100, 103, 104, and 114-124
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other:

## ATTACHMENT

The newly proposed claim amendments will not be entered because they raise new issues requiring further search and consideration. Specifically, the newly amended recitation of a “closed” system to all the claims, the newly amended recitation of a mechanism which “automatically” controls individually the division and differentiation of the first cell and the second cell in claim 70, the newly amended recitation of the mechanism for “automatically” introducing quiescence media, in claim 74, the newly amended recitation of a robotic mechanism which includes a robotic arm that “automatically” dispenses and a mechanism that “automatically” controls the environment, in claim 80, and the newly amended recitation of a biochamber being a “closed system” and an image recognition system for analyzing “each cell” of the cells “over time” in claim 114, raise new issues and require further search and consideration under 35 USC 102 and 35 USC 103. The response asserts at page 9 that the claims have been amended to include limitations suggested by the examiner, and so are present in the claims. This is noted, however, in the previous office action, the examiner did not indicate or suggest that such would make the claims allowable. Further, the newly proposed claims are different in scope than the claims already issued in the ‘010 patent. In addition, the proposed amendment to claim 1, of “a mechanism for automatically determining the state of said individual cell of the plurality of cells over time of the plurality of cells”, raises new issues under 35 USC 112/2nd paragraph. Therefore, the newly proposed claim amendments will not be entered and applicants arguments directed to the newly proposed claims will not be addressed. With regard to arguments reiterated from the last response, the rejections made in the previous office action are maintained for the reasons already made of record in the previous office actions and “Response to Arguments”.

At page 20, the response notes that the examiner states in the previous office action (final rejection), with regard to the argument made by applicants that the references cannot be combined, that 1) the claims do not have the "closed" limitation and 2) the claims are broadly written. The response asserts that these arguments have nothing to do with the fact that the cited references cannot be combined. This argument has been thoroughly reviewed but was found unpersuasive. As stated in the previous office action, the claims are broadly written and generally recite mechanisms with certain functions without specific structural embodiments to the mechanisms themselves or how they are connected. Therefore, this general lack of specific structural embodiments in the claims, as well as the lack of a recitation of the system being open or closed is relevant to whether extensive manipulation would be required of the ordinary skilled artisan to combine the teachings of the cited prior art to arrive at instantly claimed invention.

At page 23 of the response, applicants request that the examiner specifically identify by column and line number, where in Weinreb it teaches that a "cell by cell analysis provides more information for the understanding of biological implications and makes it possible to realize such an analysis very quickly and accurately". Applicants are directed to column 6, lines 58-63 of Weinreb, as well as to page 9 of the previous office action where such information was specifically cited. With respect to the argument that the Examiner is ignoring the context of the teachings of Weinreb, or Maruhashi, this argument has been thoroughly reviewed but was found unpersuasive. The examiner has not ignored the individual teachings of each reference, however, the references were not cited individually, but in combination, and the examiner specifically pointed out why one of ordinary skill in the art would be motivated to modify the apparatus of Maruhashi given the teachings of Weinreb as well as the apparatus of Weinreb, and the apparatus of Shuler which specifically teaches a closed system with multiple compartments so that different

cell samples or different drugs or cellular metabolites or different concentrations of drugs or cellular metabolites can be tested simultaneously (col. 2, lines 39-47, col. 3, lines 17-42).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Jehanne Souaya  
Patent examiner  
Art Unit 1634

2/26/03